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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Rong Duan et al.

Date: October 3, 2005

Serial No.: 10/764,162

Group Art Unit: 2823

Filed: January 22, 2004

Examiner: Fernando L. Toledo

For: SYSTEM FOR REDUCING OXIDATION OF ELECTRONIC DEVICES

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Sir:

Responsive to the Restriction Requirement mailed September 12, 2005, Applicant elects Group I, claims 1-10 drawn to the apparatus, with traverse.

It is agreed that the inventions are related as to process and apparatus for its practice. A conclusory statement that the process can be practiced by a different apparatus or by hand or that the apparatus can be used to practice another materially different process may be true in many cases, but because the way the method claims are phrased, it is submitted that that Rule is inapplicable to the present invention.

The Examiner's comment that the apparatus can be used to etch the semiconductor substrate does not concern any of the claims. Claim 1 concerns a holding device for securing a semiconductor device to a platform and which includes an opening. Relatively inert gas is supplied to the opening to reduce oxidation of the substrate. There is no mention of etching.

For example, method claim 11 is a method of operation which is performed within a cavity having several features. There is a method analog for every element in product claim 1, and vice versa. In view of the structural elements in the method steps of claim 11, it is submitted that examination of the product and method would overlap in any event and that if any teachings as in claim 1 were found in the prior art, they would be applicable to non-elected claim 11.

Method analogs for several other of the product claims may be found in the method claims, for example, claims 2 and 12, 3 and 13, 8 and 14, and 10 and 16. The two groups of

claims are so closely related and so overlapping in their elements that restriction here appears inappropriate.

It is submitted further that the criteria for requiring restriction between method and apparatus claims does not apply to the claims here, because of the analogous nature of the respective elements of the apparatus and method. Each group of claims may fall into a different subclass, but because of the way the claims are framed, it is believed that a search for either group of claims would have to involve both the subclasses named. It is submitted that the inventions are neither separate nor distinct but rather belong together and should be examined together.

Reconsideration of the Restriction Requirement and examination of all of the claims in this application is requested, therefore.

According to MPEP 806.05(e), which applies, the Examiner should provide reasonable examples that recite material differences between the apparatus and the process, and this did not appear in the Restriction Requirement. This is especially so as the Applicant has provided argument about the absence of material differences between the groups of claims for having the groups restricted.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 3, 2005.

Respectfully submitted,

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